

REMARKS

In the Office Action¹, the Examiner rejected claims 19-21 under 35 U.S.C. § 101; rejected claim 23 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-6, 8, and 10-23 under 35 U.S.C. § 103(a) as being unpatentable over Template Software product line ("SNAP") in view of U.S. Patent No. 5,872,973 to Mitchell et al. ("*Mitchell*").

Applicants thank Supervisory Examiner Bullock for the telephone interview on November 3, 2008. During the interview, the pending claims, Office Action, and *Mitchell* were discussed. The Examiner stated that amending the independent claims to recite "refactoring . . . while updating existing references within a given scope of the refactor without invalidating all existing references" would allow the claims to overcome the cited prior art.

Applicants have amended claims 1, 10, 12, 19-21, and 23. Claims 1-6, 8, and 10-23 remain pending.

I. Rejection of Claims 19-21 under § 101

Applicants respectfully traverse the rejection of claims 19-21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have amended claim 19 to recite a "computer-readable storage medium storing a program for causing a computer to perform a method for developing an application" in place of the previous recitation of a "computer program product containing instructions which, when executed on a processor, form a system for developing an application." Applicants

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

have amended claims 20 and 21 to recite a “computer-readable storage medium” in place of the previous recitations of a “system.” Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 19-21 under 35 U.S.C. § 101.

II. Rejection of Claim 23 under § 112, ¶2

Applicants respectfully traverse the rejection of claim 23 under 35 U.S.C. § 112, second paragraph. The Office Action asserts, “[c]laim 23 recites the limitation ‘refractor’ . . . There is insufficient antecedent basis for this limitation in the claim. It is believed the word should be refactor” (Office Action at page 2). Applicants have amended claim 4 to recite “refactor” instead of “refractor.” Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 23 under 35 U.S.C. § 112, second paragraph.

III. Rejections of Claims 1-6, 8, and 10-23 under § 103(a)

Applicants respectfully traverse the rejection of claims 1-6, 8, and 10-23 under 35 U.S.C. § 103(a) as being unpatentable over *SNAP* in view of *Mitchell*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “The mere fact that references can be combined or modified does not render the resultant combination

obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III)*, *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, *internal citations omitted* (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Independent claim 1, as amended, recites a method for developing an application, including, for example, “enabling a user to refactor a copied one of the development objects to modify a key attribute of the copied one of the development objects while updating existing references within a scope of the refactor without invalidating all existing references” (emphasis added).

Mitchell discloses “[c]reating dynamic connections through the edit process creates links between objects . . . without compromising independence of the objects involved” (col. 23, line 66 - col. 24, line 2). Fig. 4 of *Mitchell* illustrates a dialog that is presented to a user for building a “list of semantic links that make up this connection” between two objects (col. 25, lines 7-10). *Mitchell* also discloses “internal object

mapping for the object itself” (col. 25, lines 19-20). *Mitchell* does not teach or suggest “enabling a user to refactor a copied one of the development objects to modify a key attribute of the copied one of the development objects while updating existing references within a scope without invalidating all existing references” (emphasis added), as recited in claim 1. *SNAP* does not cure the deficiencies of *Mitchell*.

SNAP discloses documentation for developing software applications using the Template Software product line. *SNAP* does not teach or suggest “enabling a user to refactor a copied one of the development objects to modify a key attribute of the copied one of the development objects while updating existing references within a scope without invalidating all existing references,” as recited in claim 1

The Office Action has not properly determined the differences between the prior art and the invention of claim 1. Accordingly, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 12 and 19, though of different scope than claim 1, recite similar elements, and are thus allowable over *SNAP* and *Mitchell* for at least similar reasons as claim 1. The remaining claims depend from the independent claims, and are also allowable over *SNAP* and *Mitchel*.

CONCLUSION


In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 12, 2008

By: 
Eli Mazour
Reg. No. 59,318
Direct Telephone: (202) 408-4320